

### **REMARKS**

This responds to the Office Action mailed on July 17, 2008.

Claims 1-2, 4, 15-17, 19, 24-25, 27 are amended, claims 7-9, 12-14, 20, 22-23, 30-32 and 35-37 were previously canceled, and no claims are added; as a result, claims 1-6, 10-11, 15-19, 21, 24-29 and 33-34 remain pending in this application.

### **Information Disclosure Statement**

Applicants submitted an Information Disclosure Statement and a 1449 Form on September 5, 2007. Applicants respectfully request that an initialed copy of the 1449 Form be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

### **§ 112 Rejection of the Claims**

Claims 2, 4, 17, 19, 25 and 27 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Office Action stated that the claims contain the trademark/trade name PLAYSTATION® 2 and Microsoft XBOX® and that the use of such trademarks/trade names renders the claims indefinite. Applicant respectfully traverses these rejections for at least the following reasons.

The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph. MPEP 2173.05(u). If the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. MPEP 608.01(v). If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. *Id.* The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. *Id.* Applicant respectfully submits that the trademarks PLAYSTATION® 2 and Microsoft XBOX® identify specific video game systems, and thus have fixed and definite meanings. Applicant respectfully submits that it is abundantly clear what

is meant by these terms, and that no other term would adequately convey the identity of these video game systems. In this situation, Applicant respectfully submits that the mere use of these trademarks does not render these claims indefinite. To further prosecution, Applicant has amended claims 2, 4, 17, 19, 25 and 27 to more clearly indicate that the trademarks are an indication of the source of the goods, and not the goods themselves (as suggested in MPEP 608.01(v)).

Reconsideration and allowance of claims 2, 4, 17, 19, 25 and 27 are respectfully requested.

#### §102 Rejection of the Claims

Claims 1, 3, 5-6, 10-11, 15-16, 18, 21, 24, 26, 28-29 and 33-34 were rejected under 35 U.S.C. § 102(b) for anticipation by Hoyle Casino on Game Boy Color (<http://gameboy.ign.com/articles/164/164559p1.html>, hereinafter “Hoyle”). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P* § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that claims 1, 3, 5-6, 10-11, 15-16, 18, 21, 24, 26, 28-29 and 33-34 as amended contain elements not found in Hoyle.

For example, claims 1, 15 and 24 as amended now clarify that the components of the claimed system and operated on by the claimed method are housed within a single gaming device. For example, the gaming control unit, the primary display, the media control unit and the

adapted video game system are all housed in a gaming device. Hoyle describes an arrangement in which separate games are linked by a cable. As a result, Hoyle discloses a system in which the components are not housed in a single gaming device, instead at least two separate gaming devices linked by a cable are disclosed. Therefore, Hoyle does not anticipate claims 1, 15 or 24. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 15 and 24.

Claims 2, 3, 5-6 and 10-11 depend from claim 1, claims 16, 18, and 21 depend from claim 15 and claims 26, 28-29 and 33-34 depend from claim 24. These dependent claims inherit the elements of their respective base claims and are therefore not anticipated by Hoyle for at least the reasons discussed above regarding their respective base claims.

### §103 Rejection of the Claims

Claims 1, 3-6, 10-11, 15-16, 18-19, 21, 24, 26-29 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the IGN Staff (Xbox Specs) as evidence by Xbox.com (Xbox LAN Parties: Using System Link) in view of one or ordinary skill. The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the

Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

As discussed above, claims 1, 15 and 24 as amended recite that the components of the claimed system and the components operated on by the claimed method are housed within a single gaming device. Like Hoyle discussed above, both Xbox Specs and Xbox LAN Parties describe an arrangement in which separate gaming devices that are linked by a cable. As a result, neither Xbox Specs nor Xbox LAN Parties disclose a system in which the components are housed in a single gaming device. Rather, like Hoyle at least two separate gaming devices linked by a cable are required in Xbox Specs and Xbox LAN Parties.

Additionally, claims 1, 15 and 24 as amended recite that "the first output media includes content that is different from content of the second output media." For example, the first output media content may be a base wagering game and the second content may be a bonus portion of the wagering game. The Office Action states that the "first/second output media = 1st/2nd player's perspective", which is consistent with the disclosure in Xbox Specs and Xbox LAN Parties. Applicant respectfully submits that the content presented in Xbox Specs and Xbox LAN Parties is the same content viewed from the different perspectives of a first and second player on a first and second device. This is unlike Applicant's claims 1, 15 and 24 in at least two respects. First, Applicant's claims recite that the first output media content is different from the second output media content. The content is different content, it is not the same content viewed from two different perspectives. Second, as discussed above, the content is displayed using components that are housed in a single gaming device and are thus presented for a single player, not two players as disclosed in Xbox Specs and Xbox LAN Parties.

In view of the above, there are differences between the combination of Xbox Specs and Xbox LAN Parties and claims 1, 15 and 24. Therefore claims 1, 15 and 24 are not obvious in view of the combination. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 15 and 24.

Claims 3-6 and 10-11 depend from claim 1, claims 16, 18-19 and 21 depend from claim 15 and claims 26-29 and 33-34 depend from claim 24. These dependent claims inherit the elements of their respective base claims and are therefore not obvious in view of the combination of Xbox Specs and Xbox LAN Parties for reasons discussed above regarding their respective base claims 1, 15 and 24.

Claims 2, 17 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giancarlo Varanini (“TimeSplitters 2 to support system link”) as evidence by Alexander Lee (“iLink setup FAQ”). Claims 2, 17 and 25 depend from claims 1, 15 and 24 respectively and therefore inherit the elements of their respective base claims, including elements directed to the components of the system being housed in a single gaming device and elements directed to displaying first output media content that is different from the second output media content on the primary display and the adapted video game system. Like the references described above, both TimeSplitters 2 and iLink setup FAQ contemplate separate systems coupled by a cable and that present game content to two players on separate devices. Thus TimeSplitters 2 and iLink setup FAQ both fail to teach or suggest a gaming device in which a primary display and an adapted video game system housed in a single housing display different content from one another. Therefore the combination of TimeSplitters 2 and iLink setup FAQ fails to render claims 2, 17 and 25 obvious. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2, 17 and 25.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

Date

December 17, 2008

By



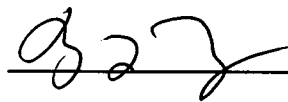
Rodney L. Laey  
Reg. No. 41,136

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Name

Rodney L. Laey

Signature



**CONCLUSION**

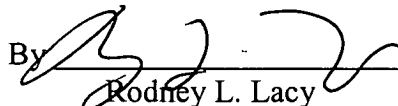
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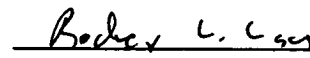
Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

Date December 17, 2008

By   
Rodney L. Lacy  
Reg. No. 41,136

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Name

  
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